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GLASS, EXAMINER

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ART UNIT	PAPER NUMBER
1501	6

DATE MAILED: 06/20/94

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

3/28/94

This application has been examined Responsive to communication filed on 3/28/94 This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), 0 days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. Notice of References Cited by Examiner, PTO-892.
2. Notice re Patent Drawing, PTO-948.
3. Notice of Art Cited by Applicant, PTO-1449.
4. Notice of Informal Patent Application, Form PTO-152.
5. Information on How to Effect Drawing Changes, PTO-1474.
6. _____

Part II SUMMARY OF ACTION

1. Claims 1 to 20 are pending in the application.

Of the above, claims _____ are withdrawn from consideration.

2. Claims _____ have been cancelled.

3. Claims _____ are allowed.

4. Claims 1 to 20 are rejected.

5. Claims _____ are objected to.

6. Claims _____ are subject to restriction or election requirement.

7. This application has been filed with Informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. Formal drawings are required in response to this Office action.

9. The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are acceptable. not acceptable (see explanation or Notice re Patent Drawing, PTO-948).

10. The proposed additional or substitute sheet(s) of drawings, filed on _____ has (have) been approved by the examiner. disapproved by the examiner (see explanation).

11. The proposed drawing correction, filed on _____, has been approved. disapproved (see explanation).

12. Acknowledgment is made of the claim for priority under U.S.C. 119. The certified copy has been received not been received

been filed in parent application, serial no. _____; filed on _____

13. Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. Other

EXAMINER'S ACTION

1. Claims 1 to 20 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

When claiming an amount it is necessary to positively recite the type (parts by weight, weight percent, parts by mole, mole percent, etc) and the basis therefor (eg. ten parts by weight of component A based on the total amount of components A and B). Applicants have failed to claim a basis for the amount of vinyl terminated polymers.

2. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

3. Claims 1 to 10, 19 and 20 are rejected under 35 U.S.C. § 103 as being unpatentable over Jensen for reasons consistent with those detailed in the parent application.

Jensen teaches an organosiloxane composition which cures to form an elastomer. Note Example 1 which demonstrates viscosities which overlap with applicants' claims, based on the conversion 1 Pa.s = 1,000 cps, approximately. Note that tetrakis(dimethylsiloxy)silane is a preferred crosslinker and

from about 10 to 60 percent by weight silica filler is disclosed. Patentee fails to teach applicants' particular diphenylsiloxy amount. However in view of the prior art and the general teachings of Jensen which include diphenylsiloxy units, one having ordinary skill in the art would have found applicants' instant invention obvious over Jensen. Specifically it is known in the prior art, as applicants admit in the specification, that it is preferable to use phenyl substitution, in the amounts claimed, when utilizing the resulting elastomer as a lens in an effort to improve the refractive index thereof. Thus in lack of a showing of new and unexpected results one having ordinary skill in the art would have been motivated with a reasonable expectation of success to use applicants' particular diphenyl-dimethyl copolymers, thus rendering these claims obvious.

With respect to claims 19 and 20, Examiner notes that it is well known in the art to use silicone elastomers as lenses. The compositions of Jensen possess properties that would be beneficial in lenses, such as high tensile strength and tear strengths. In view of this it would have been obvious to one having ordinary skill in the art to cure a lens from the curable composition of Jensen. Note column 9, line 45, which teaches the inclusion of UV absorbers.

4. Claims 11 to 16 and 18 are rejected under 35 U.S.C. § 103 as being unpatentable over Jensen as applied to claims 1 to 10, 19 and 20 above, and further in view of Reich et al. for reasons consistent with those given on page 4 of the final office action of the parent application.

Jensen fails to teach these UV absorbers, but rather generically teaches the addition of any UV absorber. However applicants' particular UV absorbers are known in the art, as demonstrated by Reich et al. and as admitted to by applicants in the specification on, for instance, page 12. Specifically Reich et al. teach the use of these UV absorbers alone or as reaction

products with SiH compounds in hydrosilation cure compositions, such as that claimed. As such one having ordinary skill in the art would have been motivated by a reasonable expectation of success to add such UV absorbers, or their reaction product with tetrakis(dimethylsiloxy)silane, to the composition of Jensen, thereby rendering obvious the instant claims.

5. Claim 17 would be allowable if rewritten to overcome the rejection under 35 U.S.C. § 112 and to include all of the limitations of the base claim and any intervening claims.

This claim requires the UV absorber to be reacted with a terpolymer of dimethyl, diphenyl and methylhydrosiloxanes. Although Reich et al. teach using the UV absorber as a reaction product with a SiH composition in hydrosilation cure compositions, one would have no motivation to use such a terpolymer in combination with the tetrakis(dimethylsiloxy)silane crosslinker required by this claim. Reich et al. teach prereacting the UV absorber with the crosslinker to be used in the curable composition but does not suggest using different SiH compounds as crosslinker and pre-reactant. Jensen fails to teach using a combination of crosslinkers and is also silent with respect to the presence of phenyl groups, or particularly such a terpolymer, in the crosslinking agent. As such this particular combination of crosslinker and different and specific siloxane used as a pre-reactant with the UV absorbers is not suggested by the prior art. As such this claim constitutes allowable subject matter.

6. Any inquiry concerning this communication should be directed to Margaret Glass at telephone number (703) 308-4334.

MWG
mwg
June 17, 1994

John C. Bleutge

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SUPERVISORY PATENT EXAMINER
GROUP 150 - ART UNIT 151